

REMARKS/ARGUMENTS

Claims 1-17 are active in the case.

Claim 1 has been amended to clarify that the particles produced are urea-modified polyester resin particles. Basis for this amendment may be found on page 6, lines 9-22 of the specification. Claim 14 has been amended to recite positively the image developer comprising the toner according to Claim 1 in the apparatus of Claim 14. Claim 15 has been amended to remove the phrase "image developers" from the Markush group and to recite the image developer comprising the toner according to Claim 1 positively in a separate step. New Claims 16 and 17 have been added to preferred embodiments. Basis for new Claim 16 may be found on page 16, lines 2-9 of the specification. Basis for new Claim 17 may be found on page 21, line 15 through page 22, line 5 of the specification. No new matter has been added into the amended claims or new claims.

The objection to the drawings has been obviated by the amendments at page 6 and page 42 of the specification deleting "1" and adding "The" before "Figure", in accordance with M.P.E.P. §608.02, page 600-94, under "(u)" Numbering of Views. Since only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear. Accordingly, it is submitted that the drawings need not be amended and that the amendment to this specification is sufficient to obviate the objection. Reconsideration and withdrawal of the requirement for corrected drawing sheets is requested.

The objection to the disclosure because of improper listing of trademarks has been obviated by amendments to the specification on pages 47, 49, 50 and 51. Basis for the recitation of the phrase "a polymeric dispersant" as a generic description of the dispersant SOLSPERSE can be found on page 21, lines 10 and 11 of the specification.

The objection to the specification in paragraph 4 on page 4 of the Official Action has been obviated by the insertion of language describing the image forming apparatus of Claim 14. No new matter has been added into the amendments to the specification.

The Examiner's Advisory in paragraph 5 on pages 4 and 5 of the Official Action that, if Claim 1 is found allowable, Claim 11 will be objected to under 37 C.F.R. §1.75 as being a substantial duplicate thereof is traversed.

Under M.P.E.P. §706.03(k) it is stated that court decisions have confirmed Applicants' right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough. There is clearly a difference in scope between Claim 1 and Claim 11, since Claim 1 is limited to a toner, while Claim 11 recites a developer. Developers are well known in the electrophotographic art area as not being limited to toner alone, but also including other materials, such as carriers, for instance. Therefore, it is submitted that claims to a toner and a developer meet the requirements of M.P.E.P. §706.03(k) for restating an invention in a reasonable number of ways. It is requested that the Examiner not object to Claims 1 and 11 under 37 C.F.R. §1.75 as being substantial duplicates of each other.

The rejection of Claim 15 under 35 U.S.C. §102(e) as anticipated by Matsuguma is traversed.

Claim 15 has been amended to delete "image developers" from the member list and the image developer is clearly separately claimed in a separate section of the claim, thereby clearly demonstrating that the developer according to Claim 1 is present in the process cartridge. Claim 15 is not anticipated by Matsuguma.

The rejection of Claim 14 under 35 U.S.C. §102(e) as anticipated by Matsuguma is traversed.

Claim 14 has been amended to recite "an image developer comprising the toner according to claim 1" and thereby clearly positively recites the toner of Claim 1 in the apparatus of Claim 14. The Examiner further states that the toner recited in Claim 14 does not distinguish the structure elements in the claimed apparatus from those in the apparatus of Matsuguma and cites *ex parte Masham*, 2 USPQ2d 1647, 1648 and M.P.E.P. §2115. The Examiner's reliance on M.P.E.P. §2115 is misplaced. The quotation from *ex parte Thibault* cited in the manual section merely relates to the purpose to which the apparatus was to be put and the contents thereof during an intended operation and does not set forth a definitive statement that any contents to be worked on during an intended operation of the apparatus in question were actually positively recited as being in the apparatus.

Further, the quotation from *in re Young* is misstated, since *in re Young* did not state "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims, but instead stated that inclusion of material worked upon by a machine as element in claim may not lend patentability, since claim is not otherwise allowable. The correct statement may be found on page 71 of the decision, second paragraph at the bottom in which the board stated "we do not deem it necessary to determine whether, where the claim otherwise patentable, the inclusion of this limitation should of itself prevent its allowance, but we do hold that its inclusion may not lend patentability since the claim is not otherwise allowable". Therefore, the court did not reach a decision on whether the inclusion of the material worked on by a machine made the machine claim patentable and should not be relied on by the Examiner to reject Claim 14. Further, in *in re Casey* the claim under appeal did not positively recite the adhesive tape to be worked on by the machine. Finally, *ex parte Masham* also did not positively recite the developer in the machine, since the operative clause states "means defining a chamber, for receiving the flowing developer material therein". Since this is not a positive recitation that the developer is in the chamber,

the next clause has no effect on the claim and is only intended use recitation. Therefore, since Claim 14 now positively recites a specific developer in an apparatus, it is submitted that the claim is not anticipated by Matsuguma, which does not teach or suggest the particular developer of Claim 14 in the apparatus of Claim 14.

The rejection of Claims 1-13 under 35 U.S.C. §103(a) as unpatentable over W02/056116, as evidenced by U.S. 2004/053155 A1, combined with U.S. 6,037,090 (Tanaka) is traversed.

The Examiner characterizes Emoto on page 15 of the Official Action as not disclosing the use of a pigment dispersant or a pigment dispersion auxiliary agent as recited in present Claims 1 and 3, respectively. However, Emoto does not teach or suggest a colorant master batch comprising: a colorant; a resin; and a pigment dispersant, as in Claim 1, nor does it disclose that the master batch is prepared by kneading a colorant, a resin and a pigment dispersant, as in new Claim 16.

Emoto merely discloses dispersing a colorant alone in an oil phase solution containing a prepolymer that is capable of forming a urea-modified polyester, followed by further additions and process steps to form the toner of Emoto.

Tanaka does not remedy the deficiencies of Emoto, because Tanaka does not teach or suggest a master batch, as recited above. In Example 1 of Tanaka a master batch is not prepared, as is recited in Claim 1, because a pigment dispersion, a resin dispersion and a wax dispersion are prepared and merely mixed in the process of forming a toner. Further, Tanaka does not disclose the formation of a master batch by kneading a colorant, a resin and a pigment dispersant, as set forth in new Claim 16. Finally, the characterization by the Examiner that Tanaka teaches as a dispersant polycaprolactone is incorrect, since the dispersant polymer of Example 1 of Tanaka is a polyester amide amine salt and not polycaprolactone. Therefore, since the combination of references fails to teach or suggest the

use of a colorant master batch, as set forth in the present claims, it is submitted that Claims 1-13 distinguish over the combination of references.

The rejection of Claims 1, 2 and 4-13 under 35 U.S.C. §103(a) as unpatentable over Emoto, as evidenced by U.S. '155, combined with JP11-237758 is traversed.

The Examiner states on page 21 of the Official Action that Emoto does not disclose the use of a pigment dispersant as recited in instant Claim 1. However, Emoto does not disclose a colorant master batch comprising: a colorant; a resin; and a pigment dispersant, as set forth in Claim 1, nor does it disclose that the master batch is prepared by kneading a colorant, a resin and a pigment dispersant, as set forth in new Claim 16.

JP-11-237758 does not remedy the defects of Emoto, since the reference does not produce a colorant master batch, as in present claims, but only produces an association of a colorant and a pigment agent, which is subjected to a flushing process to produce a resin coated pigment. There is no disclosure of a colorant master batch comprising a colorant; a resin; and a pigment dispersant and in which the toner is prepared by dissolving or dispersing a toner composition comprising a modified polyester resin and the colorant master batch in an organic solvent to prepare a liquid. JP-11-237758 does not disclose in the process of forming the toner placing a master batch into a solvent at any point in the process. Therefore, JP-11-237758 supplies only a part of the process of preparing a toner according to the present claims and there is no motivation in the reference for placing a colorant master batch in an organic solvent, as in the present claims. It is considered that the Examiner's position is a hindsight reconstruction of the prior art and does not make the claims obvious over the combination of references.

Further, JP-11-237758 does not meet the requirement of new Claim 17 that the pigment dispersant be a polymer dispersant. The pigment agents of JP-11-237758 are not polymeric agents. Finally, there is no motivation to use the resin coated pigment prepared by

the process of JP-11-237758 in place of the uncoated pigment of Emoto, since there is no advantage taught or suggested in either reference to make the substitution. Claims 1, 2 and 4-13 distinguish over the combination of references.

It is submitted that Claims 1-17 are allowable and such action is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

Customer Number

22850

Tel: (703) 413-3000  
Fax: (703) 413 -2220



Roland E. Martin  
Registration No. 48,082